IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	Customer Number: 46320
	:	
David KAMINSKY, et al.	:	Confirmation Number: 9838
	:	
Application No.: 10/652,109	:	Group Art Unit: 2178
	:	
Filed: August 29, 2003	:	Examiner: S. Termanini
	:	
For: AUTONOMIC USER INTERFACE WIDGETS		

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S

ANSWER dated December 11, 2007.

The Examiner's response to Appellants' arguments submitted in the Appeal Brief of

August 30, 2007, raises additional issues and underscores the factual and legal shortcomings in

the Examiner's rejection. In response, Appellants rely upon the arguments presented in the

Appeal Brief of August 30, 2007, and the arguments set forth below.

Rejection under 35 U.S.C. § 101

On pages 16-21 of the Examiner's Answer,[1] the Examiner set forth what the Examiner believes to be the "broadest reasonable interpretation of the claims." However, the Examiner's interpretation is, in fact, a very narrow interpretation of the claims. In the paragraph spanning pages 18 and 19, the Examiner cited the second full paragraph on page 11 of Appellants' specification, which states "[t]he present invention can be realized in hardware, software, or in a combination of hardware and software." The Examiner then concluded that broadest reasonable interpretation of the term "system" as being "a collection of software-only components." However, a broadest reasonable claim construction would include hardware and not exclude hardware, as asserted by the Examiner. By construing the claims to exclude hardware, the Examiner is narrowing the scope of claimed subject matter.

The recent decision of the Federal Circuit of In re Comiskey[2] is directed to very similar issues. Although the Court held that several claims were directed to non-statutory subject matter, the Court determined that other of the claims[3] were directed to statutory subject matter. In determining the latter, the Court stated the following:

> These claims, under the broadest reasonable interpretation, could require the use of a computer as part of Comiskey's arbitration system. (emphasis added)

Thus, the Court determined that the claims are not required to necessarily recite a computer. Instead, the Court concluded that if the claims, under a broadest reasonable interpretation, could

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[1] The Examiner's Answer is unnumbered. Thus, Appellants have started numbering from the page starting "[t]his is in response to …"

[2] Appeal No. 2006-1286.

[3] ("We consider independent claims 17 and 46 separately. They recite the use of 'modules,' including 'a registration module for enrolling' a person, 'an arbitration module for incorporating arbitration language,' and 'an arbitration resolution module for requiring a complainant [or party] to submit a request for arbitration resolution to the mandatory arbitration system.'")

1 require the use of statutory subject matter (e.g., a computer, a device, a product, etc.), then the

2 claims meet the requirements of 35 U.S.C. § 101.

3

4   Not only could claims 1-5 require the use of statutory subject matter, as argued during the

5 Appeal Brief, claims 1-5 the features recited in these claims "must necessarily be found within a

6 computer system." Since the standard, as set forth by the Federal Circuit, only requires that the

7 claims could require statutory subject matter, and since under a broadest reasonable claim

8 construction, the claimed system could include hardware, claims 1-5 meet the requirements of 35

9 U.S.C. § 101.

10

11 <u>Rejection of claim 1 under 35 U.S.C. § 102</u>

12   In response to the arguments presented on pages 9-12 of the Appeal Brief, the Examiner

13 asserted the following on page 23 of the Examiner's Answer:

14   The Examiner respectfully disagrees. Appellants have not provided lexicographic
15 definitions for "...configuring said at least one widget in the user interface...." Additionally,
16 Appellants have not claimed their invention using language falling under the scope of 35 U.S.C.
17 112, 6th paragraph. The aforementioned language does not preclude the following teachings:
18 "FIG. 20A illustrates a method 2000 for generating a graphical user interface." col. 62, lines 34-
19 35; and "The User Interface framework provides components for generating HTML. An [sic]
20 HTML page is generated from a combination of the various UI Components." col. 63, lines 1-5.
21 Appellant has not argued why any of the teachings fail to teach the claimed limitations. The scope
22 of the recited "...configuring said at least one widget in the user interface...." encompasses an
23 extremely broad range of configuring.
24

25   Appellants are again going to refer to the hypothetical claim language of "green dog,"

26 which was discussed on page 12 of the Appeal Brief. Claim 1, in part, recites "configuring said

27 at least one widget in the user interface <u>based upon a context provided by said at least one</u>

28 <u>widget</u>." The above-reproduced Examiner's arguments are essentially that many teachings in

29 Underwood disclose "configuring said at least one widget in the user interface." This is

1 comparable to the Examiner arguing that a blue dog, a brown dog, and a (color unstated) dog

2 identically discloses the claimed "dog." The claim, however, is directed to a <u>green</u> dog, and as

3 such, to establish a prima facie case of anticipation, the Examiner is required to identify a

4 teaching of a green dog. Similarly, Appellants are not just claiming configuring "configuring

5 said at least one widget in the user interface." Instead, the claim limitation, <u>as a whole</u>, is

6 "configuring said at least one widget in the user interface <u>based upon a context provided by said</u>

7 <u>at least one widget</u>." The Examiner's response in the Examiner's Answer, however, completely

8 omits the "based upon a content provided by said at least one widget."

9

10 The Examiner's statement that "[t]he scope of the recited '...configuring said at least one

11 widget in the user interface....' encompasses an extremely broad range of configuring" clearly

12 establishes that the Examiner is impermissibly parsing the limitations so as to eliminate the

13 meaning of the limitation. Appellants have narrowed the alleged "extremely broad range of

14 configuring" by including the limitation "based upon a context provided by said at least one

15 widget." However, the Examiner's analysis neglects to give this narrowing limitation any

16 apparent import.

17

18 _____

19 The Examiner's statements on pages 24-27 of the Examiner's Answer are in response to

20 the arguments presented on pages 12-14 of the Appeal Brief. A review of the Examiner's

21 comments yield a fundamental disagreement between Appellants and the Examiner as to the

22 extent of the Examiner's burden in <u>explaining</u> the Examiner's rejection. The Examiner concludes

23 on page 27 by stating:

The task of tutoring the Appellants, on subject matter of the prior art reference, is unduly burdensome, particularly when identity of terminology is present, and one of ordinary skill in the pertinent art would recognize the cited portions read on Appellants' claimed invention.

Although Appellants made this point in the first full paragraph on page 13 of the Appeal Brief, the Examiner still fails to recognize that the communications between Appellants and the Examiner is not comparable to that of an long-married coupled, who know each other so well, that they each frequently finish the other's sentence, and much can be conveyed between the two without need for much to be said. On the contrary, the prosecution file record is interpreted by the reviewing courts (i.e., the BPAI, the Federal Circuit, and the Supreme Court), as well as any District Court that may be involved in claim construction (e.g., a Markman hearing) during a patent infringement lawsuit, and these Courts do not necessarily have the luxury of Appellants' and/or the Examiner's expertise or the ability to query the Examiner's as to any ambiguities. As such, the record is to be clear and complete at the outset.

Appellants also note that the Examiner has blatantly misrepresented Appellants' prior arguments. For example, the Examiner writes "[i]t appears that the appellant is proposing that the teachings are not related to each other because they do not materialize in proximity to other teachings within the same reference." Appellants' arguments (see pages 11-12 of the Appeal Brief) was that the Examiner's cited passages, despite allegedly being to interrelated limitations, do not appear to be interrelated. Appellants are not looking to have the citations being relied upon be "in proximity to other teachings" within Underwood. Instead, Appellants are looking for an explanation, from the Examiner as to how all the cited passages interrelate to one another.

1   An example of the Examiner's failure to provide any explanation as to the Examiner's

2   analysis is found on pages 9 and 10 of the Examiner's Answer in which the Examiner purported

3   to individually map claimed elements to teachings in the applied prior art. Claim 1, in part,

4   recites the following limitation:

5   a policy comprising a plurality of business rules for configuring said at

6   least one widget in the user interface based upon a context provided by said at

7   least one widget.

8

9   As claimed, the policy is interrelated with the business rules, the business rules are interrelated

10   with the configuring of the at least one widget in the interface, and the configuring is based upon

11   a context provided by the at least one widget.

12

13   Referring to pages 9 and 10 of the Examiner's Answer, the Examiner relied upon the

14   column 321, lines 35-38 to teach the policy, column 2, lines 6-9 to teach the plurality of business

15   rules, column 119, lines 3-12 to teach the configuring of the at least one widget in the user

16   interface, and column 37, lines 10-18 to teach that the configuring is based upon a context

17   provided by the at least one widget. A review of just these passages for just this single claim

18   phrase yields several inconsistencies.

19

20   An example of an inconsistency is that column 321, lines 35-38 describes that the policy

21   information is embedded in a business component, and the Examiner's citation of column 2, lines

22   6-9 infers that the plurality of business components disclosed by Underwood corresponds to the

23   claimed plurality of business rules. Based upon these teachings, it appears that the Underwood

24   teaches that a business rule comprises policy information. However, the claim language actually

1   recites that the "policy comprising a plurality of business rules." Moreover, Underwood is

2   unclear as to whether or not the plurality of "business components" include differing policy

3   information or whether or not a combination of policy information from different business

4   components would be recognized by one having ordinary skill in the art as a "policy"

5   corresponding to that claimed.

6

7   In a shortened form, the remaining limitation's of the claim phrase at issue is that the

8   business rules configure the widget based upon content provided by the widget. To teach this

9   limitation, the Examiner cited column 2, lines 6-9, column 119, lines 3-12, and column 37, lines

10   10-18. However, the Examiner has not established that the "business component" taught by

11   Underwood is involved in the "externally stored parameters and validation rules" which are

12   allegedly used to configure the widget. Moreover, Appellants are unclear as to what feature in

13   column 119, lines 3-12 corresponds to the claimed "user interface" and what feature corresponds

14   to the claimed "widget in the user interface." Although Appellants can presume that when the

15   user enters "Illinois" on the screen, as taught by Underwood, that some user interface is used.

16   However, the Examiner's cited passage is silent as to the "widget <u>in</u> the user interface" or <u>how</u>

17   that widget is <u>configured</u>.

18

19   The Examiner's cited passage of column 37, lines 10-18 refers to method

20   "GetValueForIUField," which, as described by Underwood has a possible relationship with a

21   business component. However, this passage is <u>completely silent</u> as to the value being used for

22   "configuring at least one widget in the user interface," as claimed. Therefore, based upon the

23   limitation of "a policy comprising a plurality of business rules for configuring said at least one

widget in the user interface based upon a context provided by said at least one widget," without a need to consider any other limitations recited in claim 1, sufficient evidence exists for the Board to overturn the Examiner's rejection of claim 1.

In responding to an argument presented in the last full paragraph on page 15 of the Appeal Brief, the Examiner stated the following on page 28 of the Examiner's Answer:

> The Examiner points out that Appellants are not addressing the Examiners rejections, as applied, to each of the claimed limitations. Moreover, the "business objects" and "policy" recited in the claims, are not limited the way appellant suggests.

The reasons why the Examiner believes "Appellants are not addressing the Examiners rejections, as applied," is that Appellants have been forced to guess as to how the Examiner is construing the language of the claims and as to what features in Underwood identically disclose these limitations. The Examiner's apparent belief that Appellants' characterization of the Examiner's analysis is not accurate is reflective of the fact that the Examiner has failed to clearly <u>explain</u> the Examiner's analysis.

The Examiner's statement that "the 'business objects' and 'policy' recited in the claims, are not limited the way appellant suggests" is also reflective of the Examiner's lack of a clearly explained analysis. The Examiner asserts that Appellants' characterization of "business objects" and "policy" is wrong, yet the Examiner fails to explain either (i) why Appellants' characterization is incorrect or (ii) the characterization of these terms that this Examiner is relying upon.

1   In responding to an argument presented in the first full paragraph on page 16 of the

2   Appeal Brief, the Examiner stated the following on page 28 of the Examiner's Answer:

> 3 The Examiner points out that that the words: "...UI context..." is, inter alia, the widget's
> 4 context. Furthermore, the "context" and "configuring" recited in the claims, are not limited the
> 5 way appellant imply.
> 6

7   Notably, although the Examiner cited column 32, lines 27-28 to teach the "based upon a context

8   provided by said at least one widget" is the Second Office Action, as already noted above, on

9   page 10 of the Examiner's Answer, the Examiner is now relying upon column 37, lines 10-18.

10   These different passages cited by the Examiner, although both referring to a user interface (UI),

11   are not directed to the same teaching. Thus, the Examiner is now relying upon a different feature

12   in Underwood to teach the limitations at issue. However, as also already noted above, the

13   Examiner's cited passage of column 37, lines 10-18 still fails to establish that Underwood

14   identically discloses the claimed limitation.

15

16   The Examiner's statement that "the 'context' and 'configuring' recited in the claims, are

17   not limited the way appellant suggests" is also reflective of the Examiner's lack of a clearly

18   explained analysis. The Examiner asserts that Appellants' characterization of "context" and

19   "configuring" is wrong, yet the Examiner fails to explain either (i) why Appellants'

20   characterization is incorrect or (ii) the characterization of these terms that this Examiner is

21   relying upon.

22

23

1   <u>Rejection of claims 3 and 4 under 35 U.S.C. § 102</u>

2   In responding to separate arguments presented on pages 16 and 17 of the Appeal Brief,

3   respectively with regard to claims 3 and 4, the Examiner stated the following on page 29 of the

4   Examiner's Answer:

5   The Examiner points out that the "relationship back" to the claimed "configuring," inter
6   alia, is taught by a, "business component contained in the activity context." (col. 37, lines 10-18).
7   Furthermore, the argued meaning of said "business rules" is not limited the way Appellants imply.
8
9   This response is emblematic of the Examiner's analysis, as a whole, for all the claims and for all

10   the actions prepared by the Examiner.   Yet again, the Examiner cites a passage within

11   Underwood (i.e., column 37, lines 10-18) that has no apparent relationship to the limitations at

12   issue in claims 3 and 4. Instead, the Examiner appears to be content to rely upon Appellants or

13   the Board to make these connections for the Examiner. This reliance, however, is contrary to

14   established law that places the initial burden of establish a prima facie case of anticipation on the

15   Examiner, and not Appellants or the Board. Despite being given three opportunities to make this

16   prima facie case of anticipation with Underwood, the Examiner has failed to do so. Therefore,

17   Appellants respectfully submit that the Examiner has failed to establish a prima face case of

18   anticipation in rejecting claims 1-13 under 35 U.S.C. § 102 for anticipation based upon

19   Underwood.

20

For the reasons set forth in the Appeal Brief of August 30, 2007, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 101, 102.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: February 11, 2008   Respectfully submitted,

                                                /Scott D. Paul/
                                                Scott D. Paul
                                                Registration No. 42,984
                                                Steven M. Greenberg
                                                Registration No. 44,725
                                                Phone: (561) 922-3845
                                                CUSTOMER NUMBER 46320